

## **REMARKS/ARGUMENTS**

### **Status of the Claims**

Reconsideration of this Application and entry of this Amendment after Final are respectfully requested. With entry of this amendment, claims 1, 4, 5, and 16 have been amended and claim 3 has been canceled such that claims 1, 4-17, 19 and 20 are currently pending in the application. No new matter has been added by this amendment. The proposed amendment places the claims in better form for appeal. Additionally, this amendment addresses items brought up by the examiner in the final office action. In view of the amendments and following remarks, favorable consideration and allowance of the application are respectfully requested.

### **35 U.S.C. § 102 and 35 U.S.C. § 103 Rejections in View of Douk**

Claims 1, 3-17, and 20 stand rejected under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,911,036 to Douk *et al.*, hereinafter “Douk.” Applicants traverse the rejections under section 103 because the Examiner has not demonstrated all the elements of a *prima facie* case of obviousness. In fact, applicants find no Examiner’s argument(s) at all regarding obviousness of claims 1, 3-9, 11-17, and 20 under 35 U.S.C. § 103. Therefore, applicants respectfully request that this rejection under 35 U.S.C. § 103(a) be withdrawn. The rejection of claim 10 under 35 U.S.C. § 103(a) will be discussed farther below.

Arguing under 35 U.S.C. § 102(e), the Examiner contends that Douk discloses the structure of the invention as claimed, and further asserts that the functional limitations of claims 1 and 16 “may be” inherent in Douk. Regarding claim 1, see Detailed Action, paragraph 6, line 16 to page 4, line 5; Regarding claim 16, see Detailed Action, paragraph 10, line 5 to page 6, line 6.

Regarding the functional limitations of claims 1 and 16, the Examiner has not positively argued that Douk inherently teaches the functional limitations of claims 1 and 16, nor has the Examiner asserted the authority of the Patent Office to require applicants to “prove that the subject matter shown to be in the prior art does not possess the characteristics relied on.” Applicants dispute the notion that the functional limitations of claims 1 and 16 may be inherent characteristics of Douk. Having worked alongside inventor Nareak Douk in the field of guidewire-based embolic containment systems, applicants are prepared, if required, to provide a declaration under 37 C.F.R. § 1.132 to prove that the device of Douk U.S. Patent No. 6,911,036

does not possess the functional characteristics required in claims 1 and 16. Never-the-less, the functional limitations of claims 1 and 16 have been deleted by this amendment, rendering moot the Examiner's argument regarding the functional language of the claims.

Regarding the structural limitations of claims 1 and 16, applicants traverse the rejections under §102 because Douk fails to teach all the elements of the claims. Claims 1 and 16 are novel over Douk because Douk fails to teach

a core wire inserted through the hollow guidewire, the core wire including a tapered undulating section including a plurality of undulations along an axial portion of the core wire, wherein an amplitude of each consecutive undulation varies with axial distance from a proximal end of the core wire, the plurality of undulations frictionally contacting an inner surface of the hollow guidewire when disposed therein

as now required by claims 1 and 16, in part. By this amendment, the limitations of claim 3 have been incorporated into claims 1 and 16. Further support for this amendment can be found, *inter alia*, in paragraph 0036. By incorporating the limitations of claim 3, claims 1 and 16 now further define the shape of the tapered undulating section of the core wire. Nowhere does Douk teach a "tapered undulating core wire section" nor "wherein an amplitude of each consecutive undulation varies with axial distance from a proximal end of the core wire," as now required in claims 1 and 16.

In FIG. 6, a portion of which has been copied into the Detailed Action by the Examiner, Douk shows what the undulating section of core wire 142 looks like when bends 160 are fitted "with interference" within hollow shaft 144. At page 3, lines 2-3 of the Detailed Action mailed December 20, 2005, the Examiner conceded that Douk describes only a "constanced undulating section," instead of a tapered undulating section. In the current Detailed Action, the Examiner has mischaracterized FIG. 6 as teaching the tapered undulating section required by claims 1 and 16. Rather than defining any tapered undulating section, all bends 160 are illustrated as having equal amplitudes defined by the inside diameter of shaft 144, which restrains bends 160 from further expansion. See Douk paragraph 5, lines 44-53. Nowhere does Douk illustrate or describe consecutive bends 160 as having any difference in amplitude, one from another, whether bends 160 of core wire 142 are free-standing or fitted within shaft 144. In fact, Douk refers to the "the amplitude, or maximal dimension of bends 160" in the singular, indicating that all bends 160 are similar, or even identical in amplitude (*ibid.*). Since Douk cannot be considered to disclose a core wire including a tapered undulating section as defined by the

limitations of claims 1 and 16, then the rejection of claims 1 and 16 is improper because Douk fails to teach all the elements of the claims, as required for anticipation under 35 U.S.C. § 102.

Claim 3 has been canceled, rendering rejections of this claim moot. Claims 4-9, and 11-15 depend directly or independently from claim 1 and are patentable for the same reasons discussed above regarding claim 1. Claims 17 and 19 depend directly or independently from claim 16 and are patentable under 35 U.S.C. § 102 for the same reasons discussed above regarding claim 16.

Claim 20 is novel over Douk because Douk fails to teach

the core wire including frictional control means disposed within the hollow guidewire for providing a different amount of friction based on a translational direction of the core wire within the hollow guidewire

as required by claim 20, in part. The Examiner cites Douk column 5, lines 45-50 as teaching “that different amount of friction can be achieved by selecting the amplitude, or maximal transverse dimension of bends 160.” Applicants aver that the Examiner has mischaracterized the teachings of Douk. Douk teaches the amplitude, or maximal transverse dimension of bends 160 being selected “such that the bent portion fits, with interference, within shaft 144.” Furthermore, Douk states that the “interference fit provides sufficient friction to hold core wire 142 and shaft 144 in desired axial positions relative to each other. . .” Thus, regarding the amplitude of bends 160, Douk teaches only that such dimensions are selected to fit with interference and to provide sufficient friction to hold the parts in position. Nowhere does Douk disclose varying the amplitude to provide “a different amount of friction based on a translational direction of the core wire within the hollow guidewire,” as required by claim 20. The rejection of claim 20 is improper because Douk fails to teach all the elements of the claims, as required for anticipation under 35 U.S.C. § 102. In view of the above arguments, applicants respectfully request that all claim rejections under 35 U.S.C. § 102 be withdrawn.

*35 U.S.C. § 103 Rejection Over Douk in View of Dubrul*

Claim 10 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Douk in view of U.S. Pub. No. 2004/0236369 A1 to Dubrul. Applicants traverse the rejection under §103 because the Examiner has not demonstrated all the elements of a prima facie case of

obviousness. In particular, claim 10 depends indirectly from claim 1, which includes, in part, the following limitations that are not taught by Dubrul and Douk, either alone or in combination.

a core wire inserted through the hollow guidewire, the core wire including a tapered undulating section including a plurality of undulations along an axial portion of the core wire, wherein an amplitude of each consecutive undulation varies with axial distance from a proximal end of the core wire, the plurality of undulations frictionally contacting an inner surface of the hollow guidewire when disposed therein

The prima facie conclusion of obviousness is defective under 35 U.S.C. § 103 because the combination of Dubrul and Douk fails to teach the claim as a whole. In view of the above arguments, applicants respectfully request that the rejection of claim 10 under 35 U.S.C. § 103 be withdrawn.

Conclusion

For the foregoing reasons, Applicants believe all the pending claims are in condition for allowance and should be passed to issue. The Commissioner is hereby authorized to charge any additional fees which may be required under 37 C.F.R. 1.17, or credit any overpayment, to Deposit Account No. 01-2525. If the Examiner feels that a telephone conference would in any way expedite the prosecution of the application, please do not hesitate to call the undersigned at telephone (978) 739-3075 (Eastern Time).

Respectfully submitted,

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